

REMARKS

Claims 1, 4-5, and 7-19 are now pending in the application. Claims 1, 4-5, 7-8, 17 and 19 are amended. Claims 2-3 and 6 are cancelled. Claim 20 is new. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

ELECTION/RESTRICTION

Applicants acknowledge withdrawal of the restriction and the rejoinder of claims 13-19.

CLAIM OF PRIORITY

The Examiner states that the claim of priority cannot be made under 35 USC 119(a)-(d) based upon an application filed in Japan on 8/31/2001.

Applicants bring to the Examiner's attention the Application Data Sheet which accompanied the first filing of the subject application on February 27, 2004, wherein the Continuing Data section (page 1, paragraph 4) claims the benefit of the international filing date (30 August 2002) of the international application (PCT/JP02/08845) designating the United States of America. Further, Applicants' use of the Utility Application Transmittal (Form PTO/SB/05) rather than the Transmittal Letter To The United States Designated/Elected Office Concerning A Submission Under 35 U.S.C. 371 (Form PTO-1390) was appropriate in view of the fact that the present application was filed as a CIP of international application no. PCT/JP02/08845. (See Box 18 of Form PTO/SB/05 submitted by Applicants on February 27, 2004.)

In view of the evidence of priority to the international filing date (30 August 2002) of International Application No. PCT/JP02/08845 as well as the earlier filing date (31 August 2001) of JP 2001-264385, Applicants respectfully request correction of the Office records to reflect such priority claim.

CLAIM OBJECTIONS

Claim 17 is objected to as being unclear. Claim 17 has been amended to clarify the informality.

REJECTION UNDER 35 U.S.C. § 102

Claims 1, 3-5, 9-10, and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hosomi (U.S. Pat. No. 5,976,699).

As the Examiner is well aware, a rejection under 35 U.S.C. §102(b) can only be maintained if a single reference teaches each and every element of the claims. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).]

Applicants have amended claim 1 to include an aryl-alkyl type "epoxy resin of which moisture absorption is lower than that of both of the first cyanate resin and the second cyanate resin" from cancelled claim 2. Since Hosomi '699 does not teach any alkyl-type epoxy element now claimed, the rejection should be considered moot.

Claim 1-13 and 15-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yabuki (JP 2003-206360).

Applicants respectfully submit that the rejection in view of Yabuki '360 should be withdrawn as the reference relied upon is no longer available as prior art upon correction to the priority claim.

Claims 1, 3, 13, 15, 17, and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sakai (JP 2002-172736).

Again, Applicants have amended claim 1 to include an aryl-alkyl type "epoxy resin of which moisture absorption is lower than that of both of the first cyanate resin and the second cyanate resin" from cancelled claim 2. Since Sakai '736 does not teach any alkyl-type epoxy element now claimed, the rejection should be considered moot.

REJECTION UNDER 35 U.S.C. § 102/103

Claim 14 is rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Sakai (JP 2002-172736) or Yabuki (JP 2003-206360) or Hosomi (US 5,976,699).

Initially, Applicants note that in order to support a rejection under 35 U.S.C. §103, the Examiner must establish that there is some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434,

1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). That is, although the Examiner may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989).

Applicants respectfully submit that since claim 14 ultimately depends from claim 1, which includes elements not disclosed in the prior art, the rejection under 35 USC §102(b) is no longer appropriate.

Additionally, with regard to the alternative rejection under 35 USC §103(a), Applicants note that Yabuki '260 is not available as a prior art reference, and that neither Sakai '736 nor Hosomi '699 would have made the subject matter of claim 14, as now claimed, obvious to one of ordinary skill in the art. Claim 14 defines a prepreg having a base material impregnated with a resin composition according to claim 1. As discussed above, neither Sakai '736 nor Hosomi '699 describes or suggests a resin composition such as that defined by presently amended claim 1, which comprises (1) a first cyanate resin, (2) a second cyanate resin having a lower MW than that of the first cyanate resin, and (3) an aryl-alkyl type epoxy resin having a moisture absorption property that is less than that of both the first and second cyanate resins.

Sakai '736 describes laminated sheets formed from nonwoven glass fiber fabric prepgs that contain a thermosetting resin; this resin can be an epoxy resin. Hosomi '699 describes an insulating adhesive comprising a mixture of two different epoxy resins. Yet, neither of these references suggests the preparation of a combination of an aryl-alkyl type epoxy resin as now recited in claim 1 with cyanate resins as recited

therein. Similarly, neither of these references suggests the use of such a resin to prepare a prepreg as defined by claim 14. As a result, Applicants respectfully submit that the subject matter of claim 14 would not have been obvious to one of ordinary skill in the art. Thus, these rejections should be considered moot.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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